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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,557	04/27/2001	Shawn Gettemy	PALM-3633.US.P	3025

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EXAMINER

BELL, PAUL A

ART UNIT

PAPER NUMBER

2675

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/844,557

Applicant(s)

GETTEMY ET AL.

Examiner

PAUL A BELL

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 and 17 is/are rejected.
- 7) ☒ Claim(s) 14-20 is/are objected to.
- 8) ☒ Claim(s) 1-6 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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***Drawings***

1. The drawings are objected to because figures 1-4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application.

The objection to the drawings will not be held in abeyance.

***Election/Restrictions***

2. Claims 1-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined

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under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 7-12 are rejected under 35 U.S.C. 102(a) as being anticipated by Moon (6,229,695).

With regard to claim 7 Moon teaches a hand held device comprising; a touch panel display (figure 2, item 60) and a carrier frame (figure 2, item 40), said carrier frame comprising; at least one frame contact having an upper end and a lower end (since figure 2 item 40 has a lot of points of contact at the upper end side and lower end side it read on this broad language); wherein said upper end resides at least in part within the touch panel display mounting surface (figure 2, items 60 and 40) and said lower end is electrically accessible by circuits resident within the confines of said carrier frame (figure 2, items 70, 72 and 74).

With regard to claim 8 Moon teaches the hand held device of claim 7 wherein said carrier frame comprises a dielectric insert block (figure 2 item 50).

With regard to claim 9 Moon teaches the, hand held device of claim 8 wherein said carrier frame comprises a menta (figure 2, item 48)l.

With regard to claim 10 Moon teaches 10 the hand held device of claim 7 wherein said frame contact is press fit (figure 2 illustrates parts that are press fitted together).

With regard to claim 11 Moon teaches the hand held device of claim 7 wherein said frame contact is molded into said carrier frame (Figure 2 illustrates one solid structure for part 40 therefore it reads on molded).

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With regard to claim 12 Moon teaches the hand held device of claim 7 comprising a plurality of frame contacts distributed over said touch panel display mounting surface (figure 2, item 60 and 40 show many contact points).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in 09/844,557.

With regard to claim 13 applicant's admitted prior art teaches a hand held device comprising a touch panel display (figure 1, items 12 and 10), said touch panel display comprising a non-transparent conductive pattern (figure 2, items 21-24) adjacent to an adhesive dielectric spacer (figure 1, item 11), wherein said non-transparent conductive pattern and said adhesive dielectric spacer are visually homogeneous ( since the non-transparent conductive pattern is made up of a homogeneous material which is visually homogenous and the adhesive dielectric spacer is made up of a homogeneous material which is visually homogeneous it reads on this broad language. The applicant can overcome this rejection by stating that they both have an approximately **equal** visual homogeneous appearance.)

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Applicant's admitted prior art does not teach that the non-transparent conductive pattern and the adhesive dielectric spacer are **visible** to the user in the final assembled product (figures 3 and 4, item 31). The prior art teaches a Bezel or a Faceplate is commonly used for aesthetics reasons to cover up the non-transparent conductive pattern and the adhesive dielectric spacer at the perimeter.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to delete the bezel thereby making the non-transparent conductive pattern and adhesive dielectric spacer visible to the user because a bezel was not essential to the operation of the handheld device and to delete the bezel would lower cost of the device.

Also as an alternative to deleting the Bezel it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the bezel clear thereby making the non-transparent conductive pattern and adhesive dielectric spacer visible to the user because it is a well known practice to make a cover clear to provide a view of the electronics this is done for aesthetic reasons to market the device to the consumer who enjoys seeing the electronics. Therefore both options of either deleting the bezel or making it clear make the material below visible to the eye.

#### Allowable Subject Matter

7. Claims 14-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Bell whose telephone number is (703) 306-3019.


If attempts to reach the examiner by telephone are unsuccessful the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377 can help with any inquiry of a general nature or relating to the status of this application.

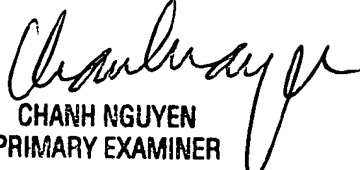
Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Or Faxed to: (703) 872-9314 (for Technology Center 2600 only)

Or Hand-delivered to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

  
Paul Bell  
Art unit 2675  
August 25, 2003

  
CHANH NGUYEN  
PRIMARY EXAMINER